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41

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,432	03/02/2004	Juergen Benz	588.1016	5411
23280	7590	07/05/2007	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018				LE, DAVID D
ART UNIT		PAPER NUMBER		
3681				
MAIL DATE		DELIVERY MODE		
07/05/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/791,432	BENZ ET AL.
	Examiner	Art Unit
	David D. Le	3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 April 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 March 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. This is the fifth Office action on the merits of Application No. 10/791,432, filed on 02 March 2004. Claims 1-22 are pending.

Documents

2. The following documents have been received and filed as part of the patent application:

- Foreign Priority Document, received on 03/02/04
- Declaration and Power of Attorney, received on 04/23/04
- Information Disclosure Statement, received on 10/17/05
- New Declaration and Power of Attorney, received on 04/07/06

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The present specification does not adequately disclose how the claimed maximum free-wheeling gear and the claimed maximum free-wheeling speed are determined or predetermined. Since the present specification does not appear to adequately disclose how the maximum free-wheeling gear or speed is determined or predetermined, it is unclear how the drivetrain can be placed in the free wheeling mode without knowing the maximum free-wheeling gear or speed.

Response to Arguments

5. Applicants' argument filed on 02 April 2007 has been fully considered but they are not persuasive.

Applicants argue,

"The maximum free-wheeling gear is a predetermined highest gear which does not vary after it is predetermined, see specification [0026], while the actual gear is the gear the transmission is in.

For example, if the maximum free-wheeling gear is, by design, the third gear in a five gear transmission, the vehicle can only enter a free-wheeling function when the transmission is in a gear equal to or less than third gear. In this example, when in first, second or third gear, the clutch can be disengaged to implement the free-wheeling function. However, in fourth and fifth gear the clutch cannot free-wheel because these gears are greater than the maximum free-wheeling gear. The same holds true for the maximum free-wheeling speed. When a vehicle speed exceeds the set maximum free-wheeling speed, for example 30 mph, the clutch is not permitted to free-wheel. However, if the Vehicle is at a speed that is equal to or less than the maximum free-wheeling speed,

for example 20 mph, the vehicle may be switched to implement the free-wheeling function.”

Paragraph [0026] of the present specification discloses,

“[0026] As an initial condition for the free-wheeling function, different parameters may be selected. First the gear should be less than or equal to a maximum free-wheeling gear. The maximum free-wheeling gear is a predetermined highest gear in which the drive train may be switched to the free-wheeling function. In addition, the gas pedal must not be operated and an idling switch must be switched by the driver to active or the driver's desired torque must be less than zero. An additional condition is that the driving speed must be less than a maximum free-wheeling speed. Above the maximum free-wheeling speed, the vehicle is also not switched to the free-wheeling function. The free-wheeling function is also not activated when driving downhill has been detected. The free-wheeling function is activated only when an automatic driving program is selected and no creep function has been activated.”

Clearly, the present specification, paragraph [0026], does not adequately disclose how the claimed maximum free-wheeling gear and the claimed maximum free-wheeling speed are determined or predetermined; and furthermore, paragraph [0026] of the present specification does not adequately support applicants' argument/example as mentioned above.

Accordingly, as set forth in paragraph 4 above, The present claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Conclusion

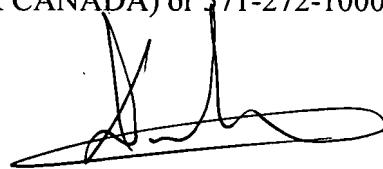
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0700-1530).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David D. Le
Primary Examiner
Art Unit 3681
06/24/2007

ddl